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40006 7590 05/21/2008 LAW OFFICE OF STEVEN B. LEAVITT, L.L.P. 130 Meadowcreek Rockwall, TX 75032				
EXAMINER CORBIN, ARTHUR L				
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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* PAUL F. MANLEY

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Appeal 2007-2770  
Application 10/784,707  
Technology Center 1700

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Decided: May 21, 2008

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Before EDWARD C. KIMLIN, BRADLEY R. GARRIS, and  
JEFFREY T. SMITH, *Administrative Patent Judges*.

SMITH, *Administrative Patent Judge*.

DECISION ON APPEAL

Statement of the Case

This is an appeal under 35 U.S.C. § 134 from a final rejection of claims 1-22. We have jurisdiction under 35 U.S.C. § 6.

Appellant's invention relates to a method for decorating foodstuff with an edible design and more particularly to decorating coated fruit with an edible design. An understanding of Appellant's invention can be gleaned from independent claim 1 which appears below:

1. A method for decorating fruit with a design, the method comprising the steps of:  
selecting a fruit;  
selecting a design to decorate the fruit;  
printing the design;  
coating the fruit with an edible, substantially water-intolerant coating; and  
attaching the design to the coated fruit.

The Examiner relies on the following references in rejecting the appealed subject matter:

Cone	5,229,149	Jul. 20, 1993
Waters	6,376,000B1	Apr. 23, 2002
Stewart	6,616,958B1	Sep. 9, 2003
Shigeo	JP 55034966 A	Mar. 11, 1980
Nakanishi, Future and Present of Edible Film, Food Packag. (Jpn), no. 5, May 1989, pp. 73-82.		

Claims 1-4, 7-19, 21 and 22 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Nakanishi<sup>1</sup>, Shigeo<sup>2</sup>, Cone, Waters, and the Admitted Prior Art in the specification<sup>3</sup>. Claims 5, 6, and 20 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Nakanishi, Shigeo, Cone, Waters, the Admitted Prior Art in the specification, and Stewart. .

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<sup>1</sup> An English-language translation of this document has been provided in the present record.

<sup>2</sup> An English-language translation of this document has been provided in the present record.

<sup>3</sup> Specification 2-3.

Appellant argues the rejected claims as a group except for claim 4. (App. Br. 3-7). Thus, we will decide this appeal based on independent claim 1 and claim 4. 37 C.F.R. § 41.37(c)(1)(vii) (2006).

We have thoroughly reviewed each of Appellant's arguments for patentability. However, we are in complete agreement with the Examiner that the claimed subject matter would have been obvious to one of ordinary skill in the art within the meaning of § 103 in view of the applied prior art. Accordingly, we will sustain the Examiner's rejections.

Appellant contends that Examiner has not shown any evidence that the method for printing a design on fruit as disclosed in Nakanishi and Shigeo would allow for a design to be printed on coated fruit. Appellant contends that one of ordinary skill in the art at the time of the invention would not have made the design modifications to the methods of Nakanishi, Shigeo, and Cone as alleged by Examiner. Appellant further contends that since Nakanishi, Shigeo, Cone, and Waters have no teaching, suggestion, or motivation for modifying the method of printing an image on uncoated fruit disclosed therein, the rejection lacks proper basis and should be withdrawn. (App. Br. 4-5).

Correspondingly, the first obviousness issue presented is: Did Appellant identify reversible error in the Examiner's rejection of claims 1-22 under § 103? We answer this question in the negative.

A claimed invention is unpatentable if the differences between it and the prior art "are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art." 35 U.S.C. § 103. "The combination of familiar elements according to known methods is likely to be obvious when it does no more

than yield predictable results.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1739 (2007). The question to be asked is “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.*

The Examiner has reasonably determined that a person of ordinary skill in the art would have found it obvious to perform the method of decorating fruit with a design comprising coating the fruit with a substantially water intolerant coating and attaching the design to the coated fruit. Specifically the Examiner has found that:

Nakanishi discloses a method of decorating fruit with a design, comprising of selecting a fruit, selecting a design, printing the design, and attaching the design to the fruit (translation, page 17), as further evidenced by Shigeo (translation, page 2). Nakanishi does not expressly disclose the coating of the fruit with an edible coating. It was conventional in the art to provide coated fruit as evidenced by Cone (column 4, line 52) and the Applicant's admission of prior art. To modify Nakanishi and print on a conventional coated fruit, rather than a conventional uncoated fruit, would have been an obvious matter of choice since Nakanishi teaches the general process of printing on fruit and coating the fruit could increase consumer appeal and enhance taste. Also, it was well known in the art to attach designs to substantially water-intolerant substances, as evidenced by Waters (abstract). Since it was known to coat fruit with substantially water-intolerant substances as taught by Cone, and also to print on such substances as taught by Waters, it would have been obvious to print on coated fruit to add to the attractiveness of the product. (Answer 3-4).

The specification describes suitable edible coatings as including “dark chocolate, milk chocolate, white chocolate, caramel, confectionary coating, or some other similar coating.” (Spec. 11).

Appellant argues that a person of ordinary skill in the art would not have made the design modifications to the methods of Nakanishi, Shigeo, Waters, and Cone as alleged by Examiner to achieve the claimed invention. (App. Br. 4-5).

We do not agree. The present record reveals that chocolate covered strawberries were known by persons of ordinary skill in this art. (Spec. 2). The specification reveals the method of attaching the design to the fruit depends on how the design is printed. If the design is printed on an edible sheet, then the edible sheet is removed from the wax paper backing and applied to the coated fruit. The specification reveals that an edible adhesive such as gum arabic may be used to attach the design to the coating. In such cases, the adhesive is allowed to dry whereby the design becomes fixedly attached to the coated fruit. (Spec. 11). Waters describes a method for creating images on chocolate. (Waters, col. 1, ll. 33-37). Waters discloses the image can be applied to a hardened preformed chocolate utilizing an adhesive. (Waters, col. 2, ll. 29-34).

Under these circumstances, we concur with the Examiner that a person of ordinary skill in the art would have had sufficient skill and creativity to adhere designs on chocolate and to coat fruits with chocolate containing said designs. A person of ordinary skill in the art who desired to decorate coated fruit with an edible design would have been led to the claimed subject matter, motivated by a reasonable expectation that the techniques utilized in decorating chocolate would have also been appropriate for decorating a food item coated with chocolate. *Cf. In re Ludwig*, 353 F.2d 241, 243-244 (CCPA 1965). (Patentability does not convey to an invention where only simple observation is required to ascertain a problem). A person

of ordinary skill in the art would have sufficient skill to select the appropriate shape and size of the design to be applied to fruit.

Regarding claim 4, the present record reveals that it was a known common method to utilize an inkjet printer to print on edible sheets. (Spec. 8). Having acknowledged that certain claimed elements are taught by the prior art, Appellant cannot now defeat an obviousness rejection by asserting that the cited references fail to teach or suggest these elements. See *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1570 (Fed. Cir. 1988) (“A statement in a patent that something is in the prior art is binding on the applicant and patentee for determinations of anticipation and obviousness.”); *In re Nomiya*, 509 F.2d 566, 571 n.5 (CCPA 1975) (It is a “basic proposition that a statement by an applicant, whether in the application or in other papers submitted during prosecution, that certain matter is ‘prior art’ to him, is an admission that that matter is prior art for all purposes . . .”).

Claims 5, 6, and 20 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Nakanishi, Shigeo, Cone, Waters, the Admitted Prior Art in the specification, and Stewart. .

Appellant has only presented arguments as to independent claim 1 (rejection discussed above) and have not otherwise presented separate arguments on the merits for claims 5, 6, and 20. In this regard, Appellant does not assert non-obviousness based on the additional limitations set forth in any of the claims 5, 6, and 20 subject to this rejection by explaining how the additional references applied thereto by the Examiner fail to establish the obviousness of the additional features recited in these separately rejected dependent claims. Because we do not find Appellant’s arguments persuasive as to independent claim 1, it follows that these arguments also are unpersuasive as to claim 4.

Under the circumstances recounted above, it is our determination that the applied references evidence establishes a prima facie case of obviousness within the meaning of 35 U.S.C. § 103. Because the Examiner has carried his burden of establishing a prima facie case of obviousness and because the Appellant has offered evidence of nonobviousness, we must now consider anew the issue of obviousness with due regard for all evidence relevant to the ultimate conclusion. *In re Rinehart*, 531 F.2d 1048, 1052 (CCPA 1976).

Appellant contends that the declaration of Paul F. Manley, signed 17 June 2005, explains that the methods described in Waters, which deal with molds, would not work with enrobed fruit due to the inconsistent shape of the fruit.<sup>4</sup> (App. Br. 5).

The Declarant's opinion is not persuasive. The Declarant opinion is limited to a discussion of the Waters reference.<sup>5</sup> Further, the Declarant does not address the entire disclosure of Waters, specifically the portions of the reference that describe the application of a design on chocolate using an adhesive to attach an edible sheet or film. We note that the Declarant has not indicated that it was unknown to adhere designs on chocolate or that it was unknown to coat fruits, such as strawberries, with chocolate. We also note that the Declarant has not indicated that a person of ordinary skill in the art would not have sufficient skill to select the appropriate shape and size of the design to be applied to fruit.

For the foregoing reasons and those presented in the Answer, the rejection of claims 1-22 under 35 U.S.C. § 103(a) is affirmed.

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<sup>4</sup> Paul F. Manley is the named Appellant.

<sup>5</sup> The Waters reference is included along with several other references in the rejection of the claimed subject matter.



ORDER

The rejection of claims 1-22 under 35 U.S.C. § 103(a) is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

tc

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